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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,383	09/16/2003	Arun Prasad	4982/27	1610
29858	7590	03/09/2006		
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			EXAMINER LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/663,383	<b>Applicant(s)</b> PRASAD ET AL.	
	<b>Examiner</b> Etienne P. LeRoux	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

*Claim Status:*

Claims 1-21 are pending. Claims 1-21 are rejected as detailed below.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 17 recites “taking the storage device off line for a backup or a restore when the inventory is being performed.” The specification does not contains a clear and concise of the manner and process of taking an inventory when the device that is being inventoried is taken off line such that a skilled artisan can make and use the invention.

*Art Rejection Precluded*

Claim 17 is rejected under 35 USC first paragraph as failing to comply with the enablement requirement. No art rejection is made in this Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 12-14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,426,284 issued to Doyle (hereafter Doyle).

Claims 1, 12-14 and 21:

Doyle discloses a management server [Doyle, Fig 2, 214], a media agent connected to the management server [Fig 2, 216]; a storage device connected to the media agent [Fig 2, 218 ; and a database [Fig 2, 210] connected to the management server; wherein the management server controls the media agent to monitor for the addition or removal of a piece of media in the storage device;

and when the media agent determines that the piece of media has been added to the storage device or removed from the storage device, the media agent causes the storage device to read a media label stored as data on the piece of media, the media label including an identifier identifying the piece of media [Doyle, Fig 4].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 15, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of US Pat No 5,884,067 issued to Storm et al (hereafter Storm).

Claims 2, 15, 18 and 20 :

Doyle discloses the elements of claim 1 as noted above but does not disclose the storage device returns the piece of media to a slot in the storage device; and the management server updates a slot table in the database with a confidence parameter indicating a confidence level of the piece of media stored in the slot. Storm discloses the storage device returns the piece of media to a slot in the storage device; and the management server updates a slot table in the database with a confidence parameter indicating a confidence level of the piece of media stored in the slot [col 13, lines 50-65]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Doyle to include the storage device returns the piece of media to a slot in the storage device; and the management server updates a slot table in the database with a confidence parameter indicating a confidence level of the piece of media stored in the slot as taught by Storm for the purpose of providing a slot error feature [col 13, lines 50-65].

Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Pub No 2002/0076206 issued to Hyatt (hereafter Hyatt).

Claim 3:

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Doyle discloses the elements of claim 1 as noted above but does not disclose wherein the storage device does not have a bar code reader. Hyatt discloses wherein the storage device does not have a bar code reader [paragraphs 7 and 19]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Doyle to include wherein the storage device does not have a bar code reader as taught by Hyatt for the purpose of providing a means of identifying an article by a means other than a bar code reader.

Claims 4–10:

Doyle discloses a management server [Doyle, Fig 2, 214], a media agent connected to the management server [Fig 2, 216]; a storage device connected to the media agent [Fig 2, 218]; and a database [Fig 2, 210] connected to the management server; wherein the management server controls the media agent to monitor for the addition or removal of a piece of media in the storage device.

Doyle discloses the essential elements of the claimed invention as noted above but does not disclose when the media agent determines that the piece of media has been added to the storage device, the media agent causes the storage device to write a media label stored as data on the piece of media, the media label including an identifier identifying the piece of media. Hyatt discloses when the media agent determines that the piece of media has been added to the storage device, the media agent causes the storage device to write a media label stored as data on the piece of media, the media label including an identifier identifying the piece of media [paragraphs 7 and 19]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Doyle to include when the media agent determines that the piece of media has been added to the storage device, the media agent causes the storage device to write a media

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label stored as data on the piece of media, the media label including an identifier identifying the piece of media as taught by Hyatt for the purpose of providing a means of identifying an article by a means other than a bar code reader.

Note: Regarding claim 5, examiner maintains that creating a label for the media inherently creates backup data for the media.

Claim 11:

The combination of Doyle and Hyatt discloses the elements of claim 9 as noted above and furthermore discloses wherein when the test piece of media does not correspond to the desired piece of media, the system indicates that the desired piece of media has been exported from the storage device [Doyle, col 6, lines 45-55].

Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle in view of Pub No 2003/0163399 issued to Harper et al (hereafter Harper).

Claim 16:

Doyle discloses the elements of claim 13 as noted above but does not disclose storing in the database a time, in association with the identifier when the inventory was performed. Harper discloses storing in the database a time, in association with the identifier when the inventory was performed [paragraph 83]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Doyle to include storing in the database a time, in association with the identifier when the inventory was performed as taught by Harper for the purpose of maintaining an accurate count of the units that a business has for sale.

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Claim 19:

The combination of Doyle and Harper discloses the elements of claims 13 and 16 as noted above and furthermore discloses searching for a desired piece of media based on the respective times stored in the database [Doyle Fig 2, 218]

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

March 3, 2006

